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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/462,703	06/05/1995	GARY D. HODGEN	SCH1309-C1	7915

23599 7590 05/16/2006

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EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/462,703	Applicant(s) HODGEN ET AL.	
	Examiner Edward J. Webman	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-134 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42-107 is/are allowed.
- 6) ☒ Claim(s) 108-134 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Per applicants' remarks filed 2/6/06 herein, the decision filed 1/30/06 on the petition filed 12/28/05 has been considered in regard to the instant application, giving full faith and credit to the action filed 12/6/05 herein.

In view of applicants' paper filed 12/28/05 adding back original claims 1-27, filed 6/5/95, as new claims 108-134, the examiner adopts the rejection under 35 USC 112 in the action filed 9/12/95 concerning the original claims and applies it to the reintroduced claims:

Claims 108-134 are rejected under 35 U.S.C. j 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 108 is indefinite due to the word "also" in the penultimate line of the claim. It is unclear why the word is necessary after the word "optionally". It is suggested that the word "to" be substituted for "also". Claim 110 is indefinite because the word "progestin" has no preceding article which suggests that the compound intended is the specific compound progestin rather than the general class of progestins. Claim 118 is similarly indefinite as there is no article preceding either "estrogen" or "progestin". Furthermore, claim 118 is indefinite because there is no antecedent basis in claim 94 for the term "progestin". Claims 121-122 and 126 are indefinite because they lack antecedent basis for the word "progestin". Claim 128 is indefinite due to the phrase "at least about 20" when the claim later stipulates that 21 tablets are necessary to be effective. The phrase "at least about 20" is confusing in view of the later stipulation. Claims 133 and 134 are indefinite because they are composition claims but improperly refer back to method claim 126. Claims 26 and 27 are also indefinite because the lower range of ethinyl estradiol lies outside the range of

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claim 132 (from which claims 133 and 134 presumably depend. Further norethindrone acetate in claim 133 and gestodene in claim 134 lack an antecedent basis in claim 132 which instead recites the progestin norethindiol.)

Applicants are reminded that, according to the paper filed 7/19/96, applicants added claims 82-107 to replace cancelled claims 1-27, addressing the 112 rejections made in the paper filed 9/12/95 over claims 1-27. Thus, amendments to overcome the instant rejection over claims 108-134 may result in claims which inadvertently duplicate claims 82-107.

Claims 42-107 are allowed. Claims 108-134 are rejected.

Suggested Interference

Applicant is directed to 37 CFR 41.202 for suggesting an interference.


(a) An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

- (1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,
- (2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,
- (3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of Section 41.203(a),
- (4) Explain in detail why the applicant will prevail on priority,
- (5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and
- (6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 571-272-0633. The examiner can normally be reached on M-F from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Richter, can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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